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Attorney's Docket No. 002964.P012

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application for:)
Joe G. Naylor, et al.)
Serial No.: 09/187,332)
Filed: November 6, 1998)
For: ONE-TOUCH SYSTEM FOR SENDING)
ELECTRONIC MAIL AND FACSIMILES)
FROM A FAX MACHINE- UTILITY)

Examiner: Harrell, Robert B.
Art Unit: 2142

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REPLY BRIEF

Mail Stop Appeal Brief - Patents
Commissioner for Patents
Post Office Box 1450
Alexandria, Virginia 22314-1450

Dear Sir:

In response to an Examiner's Answer mailed June 16, 2004 in connection with the subject patent application, Appellants submit this Reply Brief.

The Examiner's response to Appellants' argument begins at page 5 of the Examiner's Answer. Referring now to that page of the Examiner's Answer and in particular paragraph 1.a), it is stated that column 1 and column 2 of the relied upon art reference of U.S. Patent 5,805,298 to Ho et al. ("Ho") refer to a system that can be "configured appropriately". This allegedly lays open an invitation to modify Ho's system beyond that which was disclosed. Appellants respectfully disagree that this characterization of Ho suggest a modification in accordance with Appellants' claim 19

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(for example). The section in column 1 and in column 2 of Ho that has been relied upon and referenced in the Examiner's answer is paraphrased below:

"While general purpose computers, when configured appropriately with a fax/data modem which receives and transmits in accordance with both facsimile and data communications protocols, can transmit and receive documents in accordance with a fax or e-mail protocol, such operations are not always easy and often require a general knowledge of the use of the computer's operating environment...As can be seen from the foregoing, such operations require a number of steps including obtaining a properly configured computer and interacting with the programs on the computer to achieve the desired communication."

The reference to "configuration" above is intended to describe how a computer system is programmed and setup for operation. Thus, it can be seen that the above recited passages is merely directed to the particular case where a desktop computer has a relatively complex user interface, as compared to for example, a stand-alone fax machine. However, this does not reasonably suggest that there is a concern with reliability in the communications between the user and the recipient, such that **both** a facsimile telephone number and an electronic mail address of the same recipient be received by the communications device of Ho, so that the device can transmit a document from the user to both the facsimile telephone number and the e-mail address in response to the same instance of an actuator being activated by the user.

More importantly, the Examiner's answer does not consider each of the art references as a whole, but rather selects merely those aspects that, with hindsight, could be extracted and combined into Appellant's combination. For example, although in U.S. Patent No. 5,870,089 to Fabbio et al ("Fabbio"), a network computer system is configured to transmit a document selected by the user to more than one destination, there is no suggestion that the particular document be sent to multiple destination identifiers **for the same recipient**. Thus, even if the teachings of Ho and Fabbio could be combined by one of ordinary skill in the art, although as explained in Appellants' Appeal Brief, this is also questionable, the combination would not be obvious because it lacks the suggestion to make these destination identifiers to be those of the same

recipient, for purposes of for example, insuring reliability in communications with the recipient.

At page 6 of the Examiner's Answer, paragraph 1.c), the Examiner states that "Patents are not granted on recipient addresses alone. To whom one sends messages is a matter of routine design choice." First, Appellants are not merely seeking a patent whose sole difference is that the addresses refer to the same recipient. For instance, with respect to claim 19, Appellants' method recites that an actuator disposed on a fax machine is associated to locations in memory that contain the fax telephone number and the e-mail address of the recipient, and a converted document is sent to both of these addresses in response to the same instance of the actuator being activated by the user (where the stored fax number and e-mail address have been received from a user). This is not merely a matter of routine design choice for the user to send messages, but rather a non-obvious way of insuring that a document is delivered to its recipient using the benefit of a familiar interface for the user.

Lastly, at paragraph 1.e), the Examiner's answer to Appellant's contention that neither Ho or Fabbio teaches or suggests the use of a server for transmitting the document to both the fax number and the e-mail server (relevant to claims of Group II), is that Ho, in column 3 lines 58-61, refers to the use of a "commercial service". Once again, the rejection fails to consider the teaching of the art reference as a whole. More particularly, in Ho column 3 beginning at line 53, it is stated:

"As will be understood by those skilled in the art in view of the present disclosure, the term router is used to designate the function performed by module 107 which provides a connection between two networks which both operate in accordance with the same type of protocol; in this case - TCP/IP. The function performed by routers 107-109 may be performed by a commercial service which provides access to the internet via a dialup connection. Remote mail servers, seen at 110-111 each implement electronic mailboxes of the type seen at 104-105 to receive electronic mail messages."

The above portion of Ho merely refers to what a "router" is, in that it provides a connection between two networks that typically operate in accordance with the same type of protocol. Although it is true that a

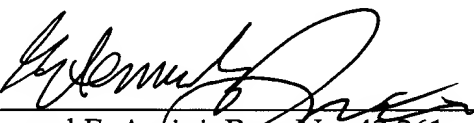
commercial service provides access to the internet by way of a dialup connection (as compared to a router), that is some type of connection between a circuit switch network and a packet switch network, there is no suggestion provided in Ho or Fabbio to provide a server as an intermediary that allows the transmissions from the fax machine, of the e-mail and fax messages, to be in accordance with a single protocol. There does not appear to be any reasonable suggestion for modifying the split path shown in Figure 1 of Ho, where the e-mail is sent from the communication device 100 to a router 107 while the fax message is sent directly to the fax machine 102, or 103 over a PSTN fax protocol.

For the reasons given above, Appellants request that the Board overturn the Examiner's rejection of all pending claims.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN

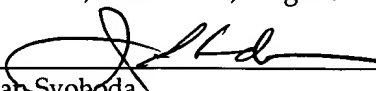
Dated: August 16, 2004


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage in an envelope addressed to: Mail Stop Appeal Brief - Patents, Commissioner for Patents, Post Office Box 1450, Alexandria, Virginia 22313-1450, on August 16, 2004.


Jean Svoboda